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EXAMINER

GAUTHIER, GERALD

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2645

DATE MAILED: 07/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/516,267

Applicant(s)

HUA ET AL.

Examiner

Gerald Gauthier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-13 and 15-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,3-13 and 15-27 is/are rejected.
- 7) ☒ Claim(s) 3,4,15 and 16 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Objections

1. **Claims 4 and 15-16** are objected to because of the following informalities:
claims 3 and 15, lines 1-2 "said handling instructions", lacked of antecedent basis.
Claims 4 and 16, line 2 "said truncation instructions" have the same problem.
Correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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4. **Claims 1, 5-8, 13, 17-20 and 25-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrick et al. (US 6,466,653) in view of Nelson (US 6,061,718).

Regarding **claim 1**, Hamrick discloses a text-to-speech preprocessing and conversion of a caller's ID in a telephone subscriber unit and method (column 1, lines 14-17), (which reads on claimed "a telecommunication system having a plurality of telephonic devices for initiating, and receiving telephone calls"), and an automated intelligent network (column 5, line 35 "advanced intelligent network") for the automated processing of telephone calls in the telecommunication system, the IN including a service control point (16 on FIG. 1) comprising call handling control logic and an SCP database (column 5, line 39 "database server provides routing") for storing information (column 5, line 40 "addressing information") used for call handling, and a plurality of switches (14 and 20 on FIG. 1) coupled to telephone devices (12 and 22 on FIG. 1) for routing calls to the telephonic devices, , the method comprising the steps of:

receiving via the SCP an arbitrary electronic text message (column 7, line 2 "the textual caller information") from a sending party (12 on FIG. 1) specifying a subscriber (22 on FIG. 1) as an intended recipient of the message (column 7, lines 1-8) [The textual caller information received by the preprocessor is provided by the database];

comparing information (column 7, line 10 "telephone listing information") in the text message received by the SCP to handling instructions stored in the SCP database

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for the subscriber (column 7, lines 9-12) [The information entered the database according to predefined sets of tables and rules]; and

based upon the comparing:

converting text in the text message to an audio message (column 7, lines 13-24) [The caller information is converted to text-to-speech synthesis];

establishing a telephone call (column 7, line 26 "an answer call event") to a telephone number designated by the subscriber (column 7, lines 25-34) [The preprocessor generates a call to the subscriber based on the telephone number on the subscriber profile]; and

transmitting the audio message during the telephone call (column 7, lines 35-46) [The preprocessor plays the audible caller information to the subscriber unit].

Hamrick fails to disclose an audio message converted from an electronic text message.

However, Nelson teaches a method of providing to a subscriber, an audio message converted from an electronic text message (column 6, lines 32-52) [The mobile subscriber chooses to have the e-mail message read to him/her by pressing a code].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use an audio message converted from an electronic text message of Nelson in the invention of Hamrick.

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The modification of the invention would offer the capability of an audio message converted from an electronic text message such as the system would be used for delivering email to messages to a standard telephone station.

Regarding **claims 5 and 17**, Hamrick discloses determining whether the subscriber also subscribes to a Caller Identification service (column 6, lines 50-54); and transmitting to the telephone number, Caller ID information comprising and indication that a telephone call received by the subscriber contains an e-mail message (column 11, lines 31-38).

Regarding **claims 6 and 18**, Hamrick discloses, wherein the Caller ID information further comprises the identity of the e-mail sending party (column 7, lines 1-8).

Regarding **claims 7 and 19**, Hamrick discloses, wherein the Caller ID information further comprises a subject matter identifier of the e-mail message (column 7, lines 1-8).

Regarding **claims 8 and 20**, Hamrick discloses, wherein the Caller ID information further comprises a portion of the text of the e-mail message (column 7, lines 1-8).

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Regarding **claim 13**, Hamrick discloses a text-to-speech preprocessing and conversion of a caller's ID in a telephone subscriber unit and method (column 1, lines 14-17), (which reads on claimed "discloses a telecommunication system adapted to provide to a subscriber, an audio message converted from a text message"), the system comprising:

a plurality of telephonic devices (12 and 22 on FIG. 1) adapted to initiate and receive telephone calls (column 5, lines 33-42) [The caller terminal unit in communication with the service switching point];

an automated intelligent network (column 5, line 35 "advanced intelligent network") adapted to automatically process telephone calls in the telecommunication system, the IN comprising a service control point (16 on FIG. 1) comprising call handling control logic and an SCP database (column 5, line 39 "database server provides routing") for storing information (column 5, line 40 "addressing information") needed in call handling, and the IN comprising a plurality of switches (14 and 20 on FIG. 1) coupled to telephonic devices for receiving and routing calls (column 5, lines 33-42) [The database server in the SCP provides routing and addressing information to the SSP]; and

a text-to-audio converter (110 on FIG. 5) adapted to convert text in an arbitrary message to an audio message (column 7, lines 13-24) [The caller information is converted to text-to-speech synthesis];

wherein the switches are adapted to route calls authorized by the SCP to a destination number specified by a subscriber (column 7, lines 25-34) [The preprocessor

generates a call to the subscriber based on the telephone number on the subscriber profile];

wherein the IN and SCP are adapted to receive an arbitrary message (column 7, line 2 “the textual caller information”) from a sending party (12 on FIG. 1) specifying a subscriber (22 on FIG. 1) as the intended recipient of the message (column 7, lines 1-8) [The textual caller information received by the preprocessor is provided by the database];

wherein the SCP is further adapted to compare information (column 7, line 10 “telephone listing information”) in the message received by the SCP to handling instructions stored in the SCP database (column 7, lines 9-12), and route the message to the telephone number specified by the intended subscriber when the handling instructions so indicate (column 7, lines 25-34) [The preprocessor generates a call to the subscriber based on the telephone number on the subscriber profile]; and

wherein the IN is adapted to generate and terminate a telephone call (column 7, line 26 “an answer call event”) to a telephone number specified by the subscriber in the SCP database (column 7, lines 25-34), and to cause to be transmitted during the telephone call, an outgoing message comprising the audio message (column 7, lines 35-46) [The preprocessor plays the audible caller information to the subscriber unit].

Hamrick fails to disclose an audio message converted from an e-mail message.

However, Nelson teaches an audio message converted from an e-mail message (column 6, lines 32-52) [The mobile subscriber chooses to have the e-mail message read to him/her by pressing a code].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use an audio message converted from an e-mail message of Nelson in the invention of Hamrick.

The modification of the invention would offer the capability of an audio message converted from an e-mail message such as the system would be used for delivering email to messages to a standard telephone station.

Regarding **claim 25**, Hamrick discloses, wherein the text-to-audio converter and the function of transmitting the outgoing message are subsumed by an intelligent peripheral integrated into a switch (column 7, lines 25-34).

Regarding **claim 26**, Hamrick discloses, wherein the text-to-audio converter and the function of transmitting the outgoing message are subsumed by a stand-alone intelligent peripheral (column 7, lines 25-34).

Regarding **claim 27**, Hamrick discloses, wherein the text-to-audio converter and the function of transmitting the outgoing message are subsumed by an intelligent peripheral integrated into a Service Node (column 7, lines 25-34).

5. **Claims 3-4 and 15-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrick in view of Nelson and in further view of Dahlén (US 5,870,454).

Regarding **claims 3 and 15**, Hamrick and Nelson as applied to **claims 1 and 13** differ from **claims 3 and 15**, in that it fails to disclose the handling instructions comprise the subscriber's e-mail address.

However, Dahlén teaches, wherein the handling instructions are customizable by the subscribers and comprise the subscriber's e-mail address, the subscriber's designated telephone number for receiving the audio messages and the subscriber's e-mail truncation instructions (column 10, lines 29-31).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the handling instructions comprise the subscriber's e-mail address of Dahlén in the invention of Hamrick and Nelson.

The modification of the invention would offer the capability of the handling instructions comprise the subscriber's e-mail address such as the system would be used for delivering email to messages to a standard telephone station.

Regarding **claims 4 and 16**, Hamrick discloses, wherein the transmitted e-mail message is truncated according to the truncation instructions specified by the subscribers (column 6, lines 63-67).

6. **Claims 9 and 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrick in view of Nelson and in further view of Shaffer et al. (US 5,995,594).

Regarding **claims 9 and 21**, Hamrick and Nelson as applied to **claims 1 and 13** differ from **claims 9 and 21**, in that it fails to disclose sending a distinctive ringing pattern.

However, Shaffer teaches, wherein the terminating step includes sending a distinctive ringing pattern corresponding the inclusion of an e-mail message in the telephone call (column 3, lines 59-67).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use sending a distinctive ringing pattern of Shaffer in the invention of Hamrick and Nelson.

The modification of the invention would offer the capability of sending a distinctive ringing pattern such as the system would be used for delivering email to messages to a standard telephone station.

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7. **Claims 10 and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrick in view of Nelson, in view of and in further view of Shaffer.

Regarding **claims 10 and 22**, Hamrick, Nelson and Dahlén as applied to **claims 3 and 15** differ from **claims 10 and 22**, in that it fails to disclose the message is urgent.

However, Shaffer teaches, wherein the e-mail message is not transmitted to a subscriber unless header information in the email message indicates that the message is urgent (column 3, lines 61-67).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the message is urgent of Shaffer in the invention of Hamrick, Nelson and Dahlén.

The modification of the invention would offer the capability of the message is urgent such as the system would be used for delivering email to messages to a standard telephone station.

8. **Claims 11 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrick in view of Nelson and in further view of Srinivasan (US 6,072,862).

Regarding **claims 11 and 23**, Hamrick and Nelson as applied to **claims 1 and 13** differ from **claims 11 and 23**, in that it fails to disclose a subscriber to enter a code.

However, Srinivasan teaches prompting a subscriber to enter a code corresponding to instructing the telecommunication system to store the audio message in a voice mailbox (column 4, lines 41-45); and

storing the audio message in a voice mailbox upon receiving the code (column 4, lines 41-45).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a subscriber to enter a code of Srinivasan in the invention of Hamrick and Nelson.

The modification of the invention would offer the capability of a subscriber to enter a code such as the system would be used for delivering email to messages to a standard telephone station.

9. **Claims 12 and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrick in view of Nelson and in further view of Nabkel (US 5,963,626).

Regarding **claims 12 and 24**, Hamrick and Nelson as applied to **claims 1 and 13** differ from **claims 12 and 24**, in that it fails to disclose a subscriber to enter a code to repeat the playing of the audio message.

However, Nabkel teaches prompting a subscriber to enter a code corresponding to instructing the telecommunication system to repeat the playing of the audio message (column 4, lines 61-67); and

repeating the playing of the audio message upon receiving the code (column 5, lines 1-7).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a subscriber to enter a code to repeat the playing of the audio message of Nabkel in the invention of Hamrick and Nelson.

The modification of the invention would offer the capability of a subscriber to enter a code to repeat the playing of the audio message such as the system would be used for delivering email to messages to a standard telephone station.

Response to Arguments

10. Applicant's arguments with respect to **claims 1, 3-13, and 15-27** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within


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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.


g.g.
June 23, 2003

FAN TSANG
SUPERVISORY PATENT EXAMINER
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